IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Brandt et al. Group Art Unit: 2174

Serial No.: 10/058,360 Confirmation No.: 5127

Filed: January 28, 2002

For: METHOD AND APPARATUS FOR DISPLAYING HELP
WINDOW SIMULTANEOUSLY WITH WEB PAGE
PERTAINING THERETO

REPLY BRIEF IN SUPPORT OF REINSTATED APPEAL TO THE BOARD OF APPEALS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant submits herewith a Reply Brief in support of its reinstated appeal to the Board of Appeals of the decision mailed March 7, 2005, finally rejecting claims 1-8 and 10-29 and of the decision mailed January 3, 2006 of the Primary Examiner reopening prosecution.

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A.   Groups 1 and 2: The Examiner is improperly picking and choosing among isolated elements in the prior art to deprecate a significant claim limitation, specifically a separate help window containing including instructions that describe how to accomplish functions in a related web page.

In its main brief, Appellant explained that neither reference teaches the element "[presenting the] help information in the help window, the help information pertaining to the web page, wherein the information in the help window includes instructions that describe how to accomplish functions in the web page." In the Examiner's brief, the Patent Office essentially concedes that this element is not found in the cited art, but argues that the Office is free to combine references any which way it chooses. *Examiner Brief at pg. 10.*

Of course, the Examiner can use multiple references in a Section 103 rejection. However, it is equally well-established that every claim element must be found in at least one of those references. *E.g., M.P.E.P. § 2143.* The Examiner's rejections fail this simple test. Instead, what the Examiner has done is to 'create' new structure not found in either reference. The Examiner performs this remarkable alchemy by alleging that Deken teaches one group of six words in a claim element and that Berry teaches a different six words of that same element.

This word-by-word parsing of a claim element is simply improper. Section 103 requires that the focus be on the obviousness of the differences between claimed inventions as a whole. *Hybritec, Inc. V. Monoclonal Antibodies, Inc. 231 USPQ 81, 93 (Fed. Cir. 1986).* The Examiner cannot pick and choose among isolated words in the claim to create corresponding structure out of thin air. *In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).* Appellant respectfully submits that the Examiner's word-by-word parsing of its claim element is exactly the type of analysis disparaged by the Federal Circuit in *Fine* and *Hybritec.*

Because at least one claim element is not found in either reference, the Examiner's Section 103 rejection is improper. Therefore, these rejections must be reversed.

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B.   Group 2: The references teach away from the proposed combination.

Appellant has noted on several occasions during prosecution that Dazey teaches:

> Another problem experienced by users is that the separate help window causes loss of focus and attention to the primary window. A window is said to have "focus" when it is active and currently designated to receive the user input from the keyboard or mouse. To navigate in a help window, the help option is activated and focus is transferred from the application window to the help window. *This shift of focus makes it confusing for the user to implement the help instructions. As the user attempts to follow the simple directions for a help topic, the efforts are not effective because the keystrokes referenced in the help window are only valid when the application window has the focus.*

Dazey, col. 1, lines 34-43 (emphasis added). Other sections of Dazey refer to a separate help window as "eas[y to] loose track of," a "hassle," awkward, lots of work, and annoying. *Dazey, col. 1, lines 25-26, 27-28, 40-41; col. 2, line 27-28.* The Examiner attempts explain away this clear 'teaching-away' by arguing that the Office only relied on Dazey to show a specific feature. *Examiner Brief at pg. 11.*

Appellant respectfully submits that the Examiner cannot simply select those portions of a reference that are useful for making a rejection, while ignoring the teaching of that reference as a whole. *In re Rouffet, 47 USPQ2d 1453, 1456* (explaining that the suggestion to make the combination must come from the prior art taken as a whole). The M.P.E.P. and the Federal Circuit make clear that the Examiner has the burden of establishing a prima facie case of obviousness. *E.g., M.P.E.P. § 2142.* To satisfy this burden, the Examiner must show that the prior art references teach or suggest all of the claimed limitations AND there is some suggestion or motivation to make the proposed combination. If the Examiner fails to satisfy either prong, the rejection must be reversed.

In this case, the Examiner failed to identify anything in the references that would motivate the combination of Dazey with Berry and Deken, and the references themselves teach directly away from the proposed combination. Appellant submits that a general statement, without citation to the art, that 'it would be obvious to make the modification' is not enough to overcome the express "teaching away" actually found in the art. *In re Fine, 5 USPQ2d 1596*

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(holding that such teaching away is compelling evidence that the claimed inventions are not obvious).

C.   Groups 1 and 2: There is no motivation to make the proposed combinations.

In its main brief, Appellant showed that nothing in the art suggests the claimed inventions. The Examiner responds by arguing that motivation can be found in the secondary reference at col. 1, lines 40-51. That section basically states that it would be desirable for a fat-client application to provide help at a location adjacent to the operating point at which the help is called.

Although the language cited by the Examiner may suggest something, it does not suggest the combination relevant to this Application. *Rouffet, 47 USPQ2d at 1456* (the prior art must suggest the desirability of the invention as a whole). As explained in Appellant's original application, fat-client help systems had been using multiple windows for years before this invention. The World Wide Web, including graphical web browsers, had also existed for many years. However, nobody had conceived merging the two paradigms before the present invention. In fact, the very art cited by the Examiner shows that those fat-client help systems and World Wide Web information sources were using completely different paradigms at the time this invention was made.

More specifically, the language relied upon by the Examiner does not suggest the desirability of combining the fat-client paradigm with the Internet paradigm, nor even providing help information about the content of the information processed by the fat-client application. Instead, just like the art described in Appellant's background section, the scope of the information present in Berry is related to information about how to perform operations in that particular fat-client application, and not about the information manipulated by and/or displayed in that application. *E.g., Berry, col. 2, lines 35-50.* Thus, the key insight identified in Appellant's original application, that "it is desirable to provide for use with a web browser a help function that presents help information that pertains, not to the browser application itself, but to

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information being displayed on a web page obtained by the browser from a server computer," is neither taught nor suggested by Berry. *Summary, page 2, lines 23-26.*

The primary reference also fails to provide the relevant suggestion. The reproduced screen-shots fail to suggest any modifications to a help system, much less that it is desirable to provide for use with a web browser a help function that presents help information that pertains, not to the browser application itself, but to information being displayed on a web page obtained by the browser from a server computer. *Summary, page 2, lines 23-26.*

Again, in the realm of user interfaces, it is all too easy to dismiss a new invention as obvious, because a new user interface almost always employs well-known devices and features that are combined in a new and different way. *Rouffet, 47 UPSQ2d at 1457* (noting that virtually all inventions are combinations of old elements). In fact, new user interfaces generally do not provide 'new function'; they simply make it easier for users to do things they can already do using conventional interfaces. But it is just because user interfaces are such a dark science that often a very subtle change in the way information is presented to or obtained from a user can result in a genuine and marked productivity improvement. Such is the case with this invention, as shown by its wide adoption subsequent to Appellant's priority date.

In the end, despite having nearly ten years to search, the Examiner has failed to present *any* web applications designed to simultaneously utilize multiple windows, nor *any* fat-client applications that present help information about the content of the information manipulated by and/or displayed in that application. For this reason, Appellant submits that the Examiner has failed to find anything in the art that teaches or suggests the claimed invention.

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For each of the foregoing reasons, Appellant submits that the Examiner's rejections of claims 1-8 and 10-29 were erroneous, and respectfully requests reversal of these decisions.

Date: October 10, 2006

Respectfully submitted,

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